

THE AMENDMENT

Claims 69-122 are in the case. Claims 69-70, 79, 92, 106, 115 and 121-122 have been amended.

The amendment to claim 69 regarding the game outcome comprising a winning or losing outcome is based on similar wording in claim 70. Further amendment to claim 69 is to change the grammar to provide proper antecedent basis regarding the two manners of movement.

The amendment to claim 70 is to delete wording now incorporated into claim 69.

The amendments to claims 79 and 92 regarding game play comprising determining the game outcome comprising a winning and losing outcome is based on similar wording in the following step of each claim. Further amendment to claims 79 and 92 regarding steps (C) and (B)(c), respectively, is to accommodate the previously indicated amendment and rephrase the indicated steps to clarify the affected claims.

[01] The amendments to claims 79, 92, 106 and 115 regarding the wording “without producing any game outcome” is to clarify the antecedent relationships between game outcomes referred to within the indicated claims; further support for this amendment is based on the disclosure in ¶ [21], [30] and [55]-[57] of Applicants’ originally filed Specification where it is clearly indicated that the invention involves moving indicators in between game rounds without producing a game outcome, activating game components without indicating a game outcome, and moving display elements in the absence of an active game.

The amendments to claims 92 and 121-122 regarding the order of specific steps are to clarify the order of moving the moveable elements in a first and second manner (see discussion under **Section 2**, below) and to address the rejection under 35 U.S.C. §112.

The amendments to the Specification at ¶ [34] are to correct typographical spelling errors that are apparent from their context.

Applicants respectfully submit that the Amendment does not introduce new matter and request that the Amendment be entered.

REMARKS

1. A Brief Review of One Embodiment of Applicants' Invention

In one embodiment of Applicants' invention, a gaming device has a moveable game element that is located in a display area and is moveable in at least a first and second manner. A controller is located in the housing and is in communication with the moveable game element. The controller determines a game outcome, which may be a winning or losing outcome. The controller preferably moves the moveable game element in a first manner during game play and in a second manner after the controller determines a threshold number of consecutive outcomes of the same type. For example, after a number of losing outcomes, the controller can move one or more of the reels in a direction opposite to the normal direction of rotation that occurs during game play.

Another embodiment of Applicants' invention comprises a method of playing a game. The method includes placing a wager and displaying a game on a gaming device. The game display preferably includes a plurality of moveable objects. The moveable objects are preferably moved in a first manner during the game. For instance, the moveable objects may be moved such that they all move in the same direction. Game play also includes determining a game outcome, which may be a winning or losing outcome. The method also preferably includes determining the number of consecutive losing events. The moveable objects are moved in a second manner if the number of consecutive outcomes of the same type is at least a threshold

number. For example, the second manner of movement may include moving the moveable objects such that they move in different directions.

In another embodiment of Applicants' invention, a gaming device has a player input device and a moveable game element. A controller is located in the housing and is in communication with the moveable game element. The controller determines a game outcome, which may be a winning or losing outcome. The controller moves the moveable game element in a first manner during game play and allows the player to use the player input device to cause the moveable game element to move in a second manner during non-game play. This feature provides a game player with the illusion that they are influencing the outcome of the game.

2. Rejection of claims 69, 92, and 121-122 as being indefinite under 35 U.S.C. §112, second paragraph.

Claims 69, 92 and 121-122 stand rejected as being unpatentable under 35 U.S.C. §112 as being indefinite. Applicants respectfully traverse this rejection.

Applicants submit that currently amended claims 92 and 121-122 now indicate that movement in the second manner clearly occurs after movement in the first manner. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 92 and 121-122 under 35 U.S.C. §112.

Applicants submit that claim 69 is not a method claim and that it would be readily apparent to one of ordinary skill in the art that the first and second manners are simply two "different" forms of movement that are clearly defined in element (D) of apparatus claim 69. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 69 under 35 U.S.C. §112.

3. Rejection of claims 69-88, 90-99 and 101-122 as being obvious over Parker et al. (GB 2062922) in view of Stupak (U.S. Patent No. 6024642).

Claims 69-88, 90-99 and 101-122 stand rejected as being unpatentable over Parker et al. in view Stupak under 35 U.S.C. §103(a). Applicants respectfully traverse this rejection.

Stupak appears to disclose a slot or video gaming machine modified to include a successive loss counter/indicator, and to pay a jackpot amount if the results of a predetermined number of successive games played on the machine are losing results.

Parker et al. appears to disclose a gaming machine having a “nudge” feature whereby a player may manipulate the outcome of a game being played during activation of the “nudge” feature by influencing the alignment of symbols to provide a winning combination.

Neither Stupak nor Parker et al. teach or suggest Applicants’ claimed invention as provided in independent claims 69, 79, 92, 106 and 115 (and corresponding dependent claims), in particular, the requirement that the second manner of object movement occurs without altering or producing a (any) game outcome.

With regard to independent claims 69, 79, 92, 106 and 115, the Office contends that it would have been obvious “... to modify the gaming machine of Parker with the special feature/award triggering event of Stupak to improve player retention ...” However, the Office has misconstrued the disclosure of Parker et al. as to how it may relate to Applicants’ claimed invention. The Office contends that the “nudge” feature of Parker et al. occurs “... at the end of the normal spin (*when the game is not being played*) ...” The Office further contends that “... no matter what the game outcome was before the nudge feature, if a player doesn’t achieve a winning outcome (e.g., only achieves a losing outcome) ... the feature doesn’t not [sic] alter the player actual game outcome. Therefore, the new limitation [Applicants’] is met.”

Applicants respectfully submit that the “nudge” feature of Parker et al. clearly corresponds to a “game being played,” regardless of the Office’s contention otherwise. Although the “nudge” feature of Parker et al. occurs when the original game is not being played, this feature clearly involves “game play producing an outcome,” an element that is precluded by Applicants’ claimed invention and that is clearly presented in the amended independent claims 79, 92, 106 and 115. There would be no incentive to one of ordinary skill in the art to combine the features of Stupak into a game (Parker et al.) that is incompatible with the requirements of Applicants’ claimed invention. Even if one were to combine the teachings of Stupak with the teachings of Parker et al., the resulting combination would operate in direct contrast to Applicants’ claimed invention. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established regarding independent claims 69, 79, 92, 106 and 115 (and their corresponding dependent claims) since “... all the claim limitations must be taught or suggested by the prior art ...” (see MPEP 2143.03). Therefore, Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

Regarding independent method claims 120-122, the Office contends that it would have been obvious “to modify Parker in view of Stupak to obtain the [Applicants’] invention as claimed because such a modification would have been considered a mere design consideration which fails to distinguish over the prior art.” The Office is apparently referring to the second manner of movement including moving the moveable objects to the first position.

However, Applicants respectfully draw the Office’s attention to the common requirement of claims 120-122 involving “moving the moveable objects in a second manner (different from a first manner during game play) when/while no game is being played.” There is no such suggestion or disclosure in either Parker et al. or Stupak of this aspect of Applicants’ invention; Indeed, Parker teaches away from this feature by providing for secondary game play involving

the “nudge” feature, where the player is able to manipulate the outcome of the secondary game via the “nudge” feature by influencing the alignment of symbols to provide a possible winning combination. The fact that a winning result/combination is possible (as disclosed in Parker et al. at pg 2:61-70) via the nudge feature clearly indicates that a game is being played, regardless of whether or not the ultimate outcome is a win or a loss. Therefore, there would be no motivation to one of ordinary skill in the art to combine the references since the suggested combination would provide incompatible features, not the required elements of Applicants’ claimed invention, as suggested by the Office.

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established regarding independent claims 120-122 since “... all the claim limitations must be taught or suggested by the prior art ...” (see MPEP 2143.03). Therefore, Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

Conclusion

Based on the arguments presented above, Applicants respectfully submit that the rejections have been overcome and request allowance of the claims. If the Office has any questions regarding the application or this response, the Office is encouraged to call Applicants’ attorney, Ian F. Burns, at (775) 826-6160.

Respectfully submitted,

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